Kraslavsky et al in view of Johnston et al, and Claims 62-64 were rejected under 35 U.S.C. §103 as being unpatentable over Kraslavsky et al in view of Cohn et al.

The specification was objected to because of the alleged introduction of new matter by the amendments filed March 9, 1998 and April 18, 1998. This rejection is respectfully traversed.

The objected to additions to the specification merely constitute well-known information and information which was incorporated into the original specification by reference. It is therefore believed that the added subject matter does not in fact constitute new matter. However, in the interest of advancing the prosecution of this application, the objected to inserts have been deleted.

Accordingly, the objection to the specification is respectfully requested to be withdrawn.

Claims 10, 12-15, 19, 36, 38-41, 45, 52-61 and 65-67 stand rejected under 35 U.S.C. §112, first paragraph. This rejection is respectfully traversed.

The specific reason why these claims were objected to is the Examiner's assertion that Internet electronic mail messages use a TCP connection protocol which is a connection mode of communication. While this is true, the actual communication between the sending machine and the receiving machine of Internet electronic mail is a connectionless mode of communication because no connection is established between the sending machine and the receiving machine. What Stevens illustrates in Figure 28.1 at page 441 is a TCP connection between two ***message transfer agents*** (not the terminal of the user who sends and the terminal of the recipient of the email). While this is a connection-mode of communication, there is no connection established between the sender and the receiver located at the left

portion of Figure 28.1. Thus, the definition of connectionless-mode of communication as set forth at page 9 of the originally filed specification is supported by conventional Internet electronic mail communication because a connection is never established between the end communication machines of the Internet electronic mail.

Further, the outstanding Office Action states, "Examiner do [sic does] not understand what protocol Applicant is using to transmit the Internet electronic mail over the Internet which is a connectionless mode of communication." However, the originally filed specification describes that the connectionless input and output processes may be according to any known Internet e-mail protocol such as used by the BSD units mail system which is incorporated into the SunOS. See page 18, lines 8-14 of the originally filed specification. Further, any Internet e-mail protocol may be used. *Id.* The Examiner does not seem to appreciate that the connectionless-mode of communication as used in the specification is between the end machines or terminals. Even though there is a connection-mode of communication used between the mail agents, there is never a connection established between the sender of the e-mail message and the receiver of the e-mail message and therefore, the term "connectionless-mode" of communication is appropriate.

However, in order to expedite the prosecution of this application, the term "connectionless" mode has been deleted from the claims and now each of the pending claims recites the transmission of a Internet electronic mail message.

Accordingly, the rejection under 35 U.S.C. §112, first paragraph is respectfully requested to be withdrawn.

Claims 16-18 and 42-44 stand rejected under 35 U.S.C. §103 as being patentable over Kraslavsky et al in view of Johnston et al. This rejection is respectfully traversed.

Initially, it is pointed out that Applicant's Attorney James Kulbaski, is extremely disappointed by the failure of the outstanding Office Action to address the deficiencies in the rejection which were fully explained by Applicant's attorney in the Amendment which was filed on March 9, 1998, was explained to the Examiner during the interview of March 27, 1998, and was briefly mentioned in the Supplemental Amendment filed April 8, 1998.

One of the points of argument raised during the interview of March 27, 1998 was that no prior art discloses or suggests the concept of transmitting information obtained from sensors as an electronic mail message over the Internet. After reviewing the prior art, during the interview, Examiner Luu appeared to agree that no prior art showed this concept but Examiner Luu felt that this concept was well-known and would provide a further explanation as to why the invention was obvious or clarify the rejection. However, despite the large effort made in terms of both time and money by Applicant's Attorney explaining the deficiencies both at the personal interview and in the amendments which were filed, Examiner Luu made no effort whatsoever to address the deficiencies of the rejection nor to respond to any of the arguments made by the Applicant's Attorney. The only explanation of the rejections set forth in the prior art is "The rejections are respectfully maintained and incorporated by reference as set forth in the last office action." The Examiner is respectfully requested to address the arguments made in the amendment filed March 9, 1998, with the understanding that the previously argued connectionless-mode of communication is now recited in the claims as an Internet electronic mail message. Specifically, the detailed rejection set forth in an earlier Office Action using Kraslavsky et al and Johnston et al is that Kraslavsky et al teach the transmitting of an Internet electronic mail message. First, the outstanding Office Action admits on p. 5 that Kraslavsky et al do not teach the use of an Internet electronic mail

message. Further, the teaching of Kraslavsky et al at column 11, lines 13-17, is the sharing of resources from one LAN to another which is the sharing of network resources. The mere fact that network resources are shared "internet" does not mean that electronic mail messages are sent. Thus, the rejection of the claims is clearly erroneous and the Examiner is respectfully requested to address the deficiencies which have been outlined in the previous Amendments.

The outstanding Office Action also contains a new prior art rejection. Specifically, Claims 62-64 stand rejected under 35 U.S.C. §103 as being unpatentable over Kraslavsky et al in view of Cohn et al. This rejection is respectfully traversed.

The outstanding Office Action on page 5 acknowledges that Kraslavsky et al do not explicitly teach the message as an Internet electronic mail message. However, with this statement made by the Examiner, the Examiner is admitting that the rejection using Kraslavsky et al in view of Johnston et al is clearly erroneous. Specifically, page 3 of the Office Action mailed December 8, 1997 states in the numbered paragraph (5) that Kraslavsky et al teach transmitting the information as an Internet electronic mail message over the Internet. However, the Examiner now on the middle of page 5 acknowledged that Kraslavsky et al do not teach that there is any transmission of an Internet electronic mail message. Therefore, the rejection using Johnston et al and Kraslavsky et al which is addressed above is clearly erroneous.

Turning back to the combination of Kraslavsky et al and Cohn et al, one of ordinary skill in the art would never combine Kraslavsky et al and Cohn et al in the manner set forth in the outstanding Office Action and therefore, the rejection is improper.

Kraslavsky et al is concerned with providing the ability to have a large amount of data communicated between the printer and the network. Specifically, the Related Art section of

Kraslavsky et al in column 1 talks about the deficiency of other ways of coupling a printer to a network. It is clear that a major problem which the invention of Kraslavsky et al overcome is the data throughput between the network and the printer. See specifically, column 1, lines 47-49 and lines 59-63. Thus, it is absolutely clear that an essential requirement of the Kraslavsky et al invention is to provide the ability to quickly communicate large amounts of data between the printer and a computer connected to the printer.

Another feature of Kraslavsky et al is the communication of data in a near real-time manner. Specifically, beginning at col. 14 of Kraslavsky et al, there is described "a Customized PCONSOLE ("CPCONSOL")." This software provides extensions "to enable access to the powerful control and monitoring features of the ... printer." *Id.* at col. 14, lines 32-34. The type of information provided by the printer includes status and control information such as "online/offline," "no response," "time/date," "font information," "layout information, " etc. This type of information is only useful if provided on a real-time or near real-time basis. Internet email has the potential to be a slow and unreliable mode of communication and certainly would not be applicable to the invention of Kraslavsky et al. For example, normally it is relevant to know if a printer is online or offline (e.g., ready to use) at the current time (a near real-time basis). If it was known whether or not the printer was usable (online), a decision could be made whether or not to send the print job to that printer. Such information would be much less useful if received with the type of delay associated with Internet email. Further, what use would time/date information of the printer be if sent via Internet email? Additionally, obtaining the status and control of the printer in view of what is described in Kraslavsky et al would not be desirable.

Additionally, this status and control information is sent to a network (e.g., a LAN) administrator in Kraslavsky et al. *Id.* at col 15, lines 3-7. A network administrator would desire to receive this information on an immediate basis, not using Internet electronic mail.

To state that it would be obvious to use an Internet electronic mail message, as disclosed in Cohn et al as the medium of communication of Kraslavsky et al is contradictory to the teachings of Kraslavsky et al.

It must be understood that if the prior art invention has as an essential purpose to increase the data throughput or have a near real-time monitoring and controlling operation, it is contrary to use one of the slowest mediums of communicating data (an Internet electronic mail message) into such a device.

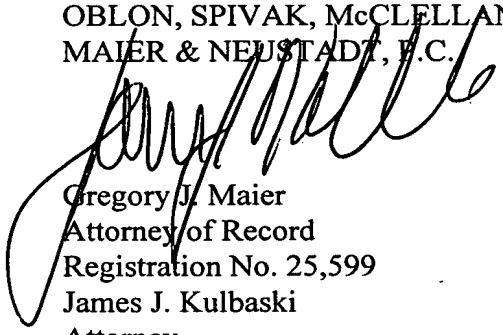
If the next communication from the PTO is not a Notice of Allowance, a detailed explanation is requested as to why one of ordinary skill in the art would be motivated to modify Kraslavsky et al to utilize one of the slowest modes of communication (Internet electronic mail message) into the Kraslavsky et al system which has as its essential purpose the requirement to achieve the transmission of a sufficient amount of data at a reasonable speed and also a near real-time mode of operation.

Based on the above-described features of the two patents used to reject the claims, one of ordinary skill in the art would never seek to combine the teachings of Cohn et al with Kraslavsky et al and therefore, the rejection under 35 U.S.C. §103 is respectfully requested to be withdrawn.

Consequently, in light of the above discussion and in view of the present amendment, the present application is in condition for formal allowance and an early and favorable action to that effect is requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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